

## **REMARKS**

### **I. Overview**

These remarks are set forth in connection with the filing of an RCE. Presently, claims 17, 19, 20, 22 and 24 are pending in the Patent Application. Claims 17, 22 and 24 are independent in nature. In the Non-Final Office Action dated June 18, 2009 (the "Non-Final Office Action"), Examiner has rejected claims 17, 19, 20 and 24 under 35 U.S.C. § 102(b) as being anticipated by "Bristow" (A008623, dated 1986). Further, claim 22 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,776,016 to Hansen.

### **II. Applicants' Amendments**

Applicants have amended claims 17, 22 and 24 to account for the machine or transformation test of Ex Parte Bilski. Specifically, the Court of Appeals for the Federal Circuit recently clarified the bounds of patent-eligible subject matter for process claims.<sup>1</sup> The Bilski court found the machine-or-transformation test the applicable test for determining patent eligibility of a process under § 101.<sup>2</sup> The Bilski court, in following the Supreme Court, enunciated the machine-or-transformation test as follows: "A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing."<sup>3</sup> In that claims 17, 22 and 24 positively recite a computer with at least one processor and memory, claims 17, 22 and 24 satisfy the machine-or-transformation test of Ex Parte Bilski and are statutory under 35 U.S.C. § 101.

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<sup>1</sup> See In re Bilski, 545 F.3d 943 (Fed. Cir. 2008) (en banc)

<sup>2</sup> Id. at 956.

<sup>3</sup> Id. at 954 (citing Benson, 409 U.S. at 70 (1972)).

### III. Rejections Under 35 U.S.C. § 102

On pages 3 and 4 of the Non-Final Office Action, Examiner rejects claims 17, 19, 20 and 24 under 35 U.S.C. § 102(b) as being anticipated by Bristow. This rejection is respectfully traversed.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.<sup>4</sup> Moreover, the anticipating prior art reference must describe the recited invention with sufficient clarity and detail to establish that the claimed limitations existed in the prior art and that such existence would be recognized by one having ordinary skill in the art.<sup>5</sup> Absence from an allegedly anticipating prior art reference of any claimed element negates anticipation.<sup>6</sup>

“Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims. ... The second step in the analyses requires a comparison of the properly construed claim to the prior art.”<sup>7</sup> During patent examination, the pending claims must be “given their broadest reasonable interpretation consistent with the specification,”<sup>8</sup> and the broadest reasonable interpretation of the claims must

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<sup>4</sup> In re Schreiber, 128 F.3d 1473, 1477 (Fed. Cir. 1997) (“To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently”), In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984).

<sup>5</sup> See In re Spada, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); Diversitech Corp. v. Century Steps Inc., 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

<sup>6</sup> Kloster Speedsteel AB v. Crucible, Inc., 793 F.2d 1565, 1571 (Fed. Cir. 1986)(emphasis added).

<sup>7</sup> Medichem, S.A. v. Rolabo, S.L., 353 F.3d 928, 933 (Fed. Cir. 2003) (internal citations omitted).

<sup>8</sup> In re ICON Health and Fitness, Inc., 496 F.3d 1374, 1379 (Fed. Cir. 2007) (“[T]he PTO must give claims their broadest reasonable construction consistent with the specification. Therefore, we look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation.”); In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

also be consistent with the interpretation that those skilled in the art would reach.<sup>9</sup> Therefore, the Examiner must (i) identify the individual elements of the claims and properly construe these individual elements,<sup>10</sup> , and (ii) identify corresponding elements disclosed in the allegedly anticipating reference and compare these allegedly corresponding elements to the individual elements of the claims.<sup>11</sup> This burden has not been met.

Specifically, Examiner has provided an improper claim construction for the critical claim term "voice utterance". In this regard, the broadest reasonable interpretation of the claim term "voice utterance" is "uttered speech". Applicants' use of the term "voice utterance" in claims 17, 20 and 24 is entirely consistent with the broadest reasonable interpretation of "voice utterance" as "uttered speech". Specifically, claim 17 by way of example requires "the conversion varying based on an evaluation of said new voiced utterance and on a previous voiced utterance" (read: the conversion varying based on an evaluation of said new uttered speech and on previously uttered speech). By comparison, Examiner provides an EXPRESS claim construction of "voice utterance" as "grammar compiler". Specifically, Examiner argues:

As per claim 17, "recognizing voiced utterances and producing corresponding input to a program for execution on a computer" is taught with his figure 11.1, page 245: "a voice recognizer for recognizing a new voiced utterance" (his recognizer); and "a converter for converting said new voiced utterance to an output string for delivery as input to said computer...an evaluation of said new voice utterance and on a previous voiced utterance" (**his grammar compiler** of figure 11.2, page 247 - as explained in section 11.2, a grammar compiler, which will accept as its input a grammar specification... relies on a particular grammar structure having multiple words such that ... at any given time in the progress of the application program, only certain words in the vocabulary will be acceptable for input).

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<sup>9</sup> In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999)

<sup>10</sup> See also, Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation... will normally control the remainder of the decisional process"); see Gechter v. Davidson, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

<sup>11</sup> Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

As it is well known, however, a grammar compiler is not speech. Rather, a grammar compiler compiles a grammar for use by a speech recognition. Indeed, a grammar itself in the context of speech recognition is not previously recognized speech, by a text description reduced to digital form in a data structure form of acceptable speech input for a speech application.

In any case, as set forth in M.P.E.P. 2111, "During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. Specifically, the Federal Circuit's en banc decision in Phillips v. AWH Corp., 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) expressly recognized that the USPTO employs the "broadest reasonable interpretation" standard.<sup>12</sup> Most certainly, construing "voice utterance" as a "grammar compiler" exceeds the legal standard for claim construction during examination and inhibits Examiner's ability to properly compare the cited art to Applicants' claims. To the extent that Examiner has misconstrued "voice utterance", Examiner has failed to locate the claim limitation of "the conversion varying based on an evaluation of said new voiced utterance and on a previous voiced utterance" in Bristow. Of course, under 35 U.S.C. § 102(b), the absence of such a limitation from Bristow negates anticipation.<sup>13</sup>

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<sup>12</sup> The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification" as it would be interpreted by one of ordinary skill in the art." In re Am. Acad. of Sci. Tech. Ctr., 367 F.3d 1359, 1364, 70 USPQ2d 1827 (Fed. Cir. 2004). Indeed, the rules of the PTO require that application claims must "conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description." 37 CFR 1.75(d)(1).

<sup>13</sup> Kloster Speedsteel, 793 F.2d at 1571.

IV. Rejections Under 35 U.S.C. § 103(a)

“[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability.”<sup>14</sup> A rejection under 35 U.S.C. § 103(a) must be based on the following factual determinations: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) any objective indicia of non-obviousness.<sup>15</sup> Applicants’ position is that the Examiner has not properly established the underlying facts regarding (1) the scope and content of the prior art and (3) the differences between the claimed invention and the prior art.

On October 10, 2007, the Patent Office issued the "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.," 73 Fed. Reg. 57,526 (2007) (hereinafter the Examination Guidelines). Section III is entitled "Rationales To Support Rejections Under 35 U.S.C. 103." Within this section is the following quote from the Supreme Court: "rejections on obviousness grounds cannot be sustained by merely conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1741 (2007) (*quoting In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

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<sup>14</sup> In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

<sup>15</sup> See KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007); DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co., 464 F.3d 1356, 1360 (Fed. Cir. 2006) (*citing Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966)).

Referring to the first column on page 57,529 of the Examination Guidelines, the following is a list of rationales that may be used to support a finding of obviousness under 35 U.S.C. § 103:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) "Obvious to try" - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Upon reviewing the Examiner's analysis in the paragraph spanning pages 5 and 6 of the Non-Final Office Action, the Examiner appears to be employing rationale (A). If the Examiner is not relying upon rationale (A), Appellants request that the Examiner clearly identify the rationale, as described in the Examination Guidelines, being employed by the Examiner in rejecting the claims under 35 U.S.C. § 103.

The Examination Guidelines set forth a precise process for which the Examiner must follow in order to establish a prima facie case of obviousness under 35 U.S.C. § 103(a). Specifically, to reject a claim based on this rationale, Office personnel must resolve the Graham factual inquiries. Thereafter, Office personnel must then articulate the following:

- (1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;
- (2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely would have performed the same function as it did separately;

- (3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and
- (4) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

With respect, Applicants' amended claim 22 results in Hansen failing to teach each element claimed.

In this regard, independent claim 22 as amended requires two features not shown by the combination of Boloker and Licciardi: (1) the coupling of the model servlet to each of the channel servlets; and, (2) the coupling of a session manager to the location registry and the managing by the session manager of the common session and the correlating by the session manager of the different channels of access by reference to the location registry. For the convenience of the Examiner, exemplary claim 1 as amended is reproduced herein in its entirety:

1. A system for enabling voiced utterances to be substituted for manipulation of a pointing device to control motion of a displayed location indicator on a computer display, the indicator being moved by an operating system in a computer in response to control signals received from the pointing device, comprising
  - a voice recognizer for recognizing a voiced utterance, and an interpreter functionally connected to said voice recognizer for converting a voiced utterance into control signals which will cause movement of the indicator in a desired direction aided by the operating system in the computer, **said movement continuing unabated until stopped by an action of the user.**

Integral to claim 22 is the "movement" of the indicator "continuing unabated until stopped by an action of the user." This teaching as admitted by Examiner on page 5 of the Non-Final Office Action cannot be explicitly found in Hansen.

Notwithstanding, Examiner asserts on page 5 that such a teaching is inherent to Hansen. Specifically, Examiner states:

It is noted that Hansen does not explicitly teach "movement continuing unabated until stopped by an action of the user". However, Figure 14, 4th box (move the cursor (XD=XN-XO, YD=YN-YO)) shows the relative calculations for movement of the cursor that would be equivalent to the calculations necessary for relative movements of a mouse to perform the same function. This is

taught as an alternative to commands such as up, down; left, right, etc. that would mimic individual keys for cursor control.

Examiner's statement on page 5, however, does not provide for the requisite evidentiary foundation to establish that inherent to Hansen is "continuing unabated until stopped by an action of the user." In this regard, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.<sup>16</sup>

To the contrary, to establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.<sup>17</sup> Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.<sup>18</sup> In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.<sup>19</sup> So much has not occurred here and as such, Hansen as a sole reference is not sufficient to establish a prima facie case of obviousness under Rationale A and 35 U.S.C. § 103(a).

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<sup>16</sup> In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art);

<sup>17</sup> In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

<sup>18</sup> In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) (The claims were drawn to a disposable diaper having three fastening elements. The reference disclosed two fastening elements that could perform the same function as the three fastening elements in the claims. The court construed the claims to require three separate elements and held that the reference did not disclose a separate third fastening element, either expressly or inherently.).

<sup>19</sup> Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)



V. Conclusion

The Applicants respectfully request the withdrawal of the rejections under 35 U.S.C. §§ 101, 102(b) and 103(a) owing to the amended specification and claims and the foregoing remarks. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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